

10/14/2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 10/528,544 Confirmation No. 3962
Applicant : Winfried K. W. Holscher
Filed : September 26, 2005
TC/A.U. : 3679
Examiner : Ernesto Garcia

Docket No. : 05-196
Customer No. : 34704

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

REPLY BRIEF

Sir:

This is in response to the Examiner's Answer mailed
June 30, 2009.

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

In the Examiner's Answer, the Examiner maintains the rejection of claims 29 and 31 - 39 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. The only claims which the Examiner has objection to are claims 29 and 35. On page 4 of the Examiner's Answer, the Examiner clearly says that claims 31 - 34 and 36 - 39 are only considered to be indefinite because they respectively depend from claims 29 and 35.

Claims 29 and 35 Are Definite

On page 4 of the Examiner's Answer, the Examiner presents his response to the Arguments presented by Appellant in Appellant's Brief. Appellant has reviewed this response and does not find any explanation as to why claims 29 and 35 fail to particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. Thus, the Examiner has not met his burden of establishing the indefiniteness of the claims.

A claim is indefinite if it fails to clearly delimit the boundary between the claimed and unclaimed subject matter. See *In re Vogel*, 422 F.2d 438, 442 (CCPA 1970). Appellant believes that both claims 29 and 35 clearly delimit the boundary between the claimed and unclaimed subject matter. Thus, both claims 29 and 35 are definite within the meaning of the second paragraph of 35 U.S.C. 112.

When examining a claim for definiteness, all elements of the claim including the preamble are to be considered. See *Ex parte Kristensen*, 10 USPQ2d 1701, 1703 (BPAI 1989). Further, the claim language is analyzed in light of the teachings of the prior art and in light of the particular application disclosure as it would be interpreted by one having ordinary skill in the art. See *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). The inquiry on the subject of the definiteness of a claim is whether the claim does in fact set out and circumscribe a particular area with a reasonable degree of precision and particularity. *Id.* As mentioned above, the Examiner provides no reason in the Examiner's Answer why one of ordinary skill in the art having the application disclosure before them and/or the teachings of the prior art would be unable to ascertain the metes and bounds, i.e. the boundary between the claimed and unclaimed subject matter, of either claim 29 or claim 35.

On page 4, the Examiner addresses the argument that in the instant case, one would readily understand the connecting device to be used to join two workpieces together and the manner in which the components of the connecting device interact with the workpieces. The Examiner contends that the claim can not be set in both ways since one would contradict the other. This argument is not understood by Appellant. Appellant submits that these two things are not contradictory at all. In fact, they are the goal of the claims - namely, to have one of ordinary skill in the art understand what the connecting device is used for and how the connecting device functions to accomplish that purpose.

The Examiner goes on to say that "... if the connecting device is actually 'interacting' with the workpieces, then the connecting device brings in the workpieces as part of the invention otherwise the workpieces would merely be intended to interact with the connecting device as set forth in the preamble and therefore the workpieces would not be part of the connecting device but inferentially recited." Appellant is not sure what this argument has to do with the definiteness of the claims under the second paragraph of section 112 of the patent statutes. Any connecting device is going to join two workpieces and cooperate with the workpieces in some manner. One of ordinary skill in the art would readily understand that. As for the "inferentially recitation" argument, it should not go unnoted that while the Examiner complains about the claim language, the Examiner has never presented any alternative language which Appellant could use to cure this alleged problem. In Appellant's opinion, that is because there is no other way to claim the invention.

Claims 29 and 35 clearly describe how the elements of the connecting device cooperate with elements of the workpieces in order to effect the connection. For example, claim 29 calls for a clamping screw which has a shank which engages in a longitudinal groove of the first workpiece and which can be inserted into an opposing element in an interior of the second workpiece. Appellant submits that such language in the claim very clearly defines the metes and bounds of the claim. If one has a clamping screw which has a shank which does not engage a longitudinal groove of the first workpiece and/or is not inserted into an opposing element in an interior of the second workpiece, one does

not infringe claim 29. Nothing could be clearer and the second paragraph of 35 U.S.C. 112, second paragraph does not require anything further. It is submitted that the boundary between the claimed and the unclaimed subject matter could not be more particularly pointed out and distinctly claimed than they are in claims 29 and 35. If they could, the Examiner in carrying out his duties would have suggested alternative language. No suggestion has been made.

With regard to the Examiner's statement that "[w]hen the workpiece is being positively recited, the question remains whether the connecting device is still 'for connecting a first workpiece' as recited in the preamble'," Appellant does not believe that such a question exists. Both claims 29 and 35 are clear - the connecting device is for joining a first workpiece to a second workpiece. Of this, there can be no doubt.

On page 5 of the Examiner's Answer, the Examiner argues:

"The claim further requires a shank of the screw 'engages in a longitudinal groove of the first workpiece'. Clearly, this limitation can not be ignored. The claim also requires, in lines 24 - 26, the 'outer ribs' be 'assigned to radial grooves in a groove bottom and in facing surfaces of the longitudinal groove.'" It is clear that the groove is the one in the first workpiece. Accordingly, the claims are rendered indefinite and thus require clarification."

The Examiner's indefiniteness position is not understood because the Examiner offers no reason why the inclusion of these limitations in the claim would render

the metes and the bounds of the claim unclear. As evidenced by the Examiner's own statement, it is readily understood that the groove is the one in the first workpiece. Appellant submits that the second paragraph of 35 U.S.C. 112 requires only reasonable clarity; however in this case, as pointed out by the Examiner, there is absolute clarity as to the meaning of the claim language. With regard to the other limitations which are mentioned, there is no explanation as to why any of the other claim limitations would also not be understood.

With regard to the Examiner's statement that "... it is the body of the claim that determines the scope of the claim and not the preamble," this position is legally incorrect. When determining the scope of the claim, i.e. the metes and bounds of the claim, the preamble is considered as well as the body of the claim. See *Kristensen*, 10 USPQ2d at 1703.

Having failed to meet the Examiner's burden of providing an explanation as to why one of ordinary skill in the art having the claims and the disclosure in the instant application before him/her could not determine the metes and bounds of claims 29 and 35, the rejection under 35 U.S.C. 112, second paragraph fails and should be reversed.

CONCLUSION

For the reasons set forth herein, and for the reasons, set forth in Appellant's brief, the rejection of record should be withdrawn and the application should be remanded to the Examiner for allowance and issuance.

FEES

No fees are believed to be due as a result of this response. Should the Director determine that a fee is due, he is hereby authorized to charge said fee to Deposit Account No. 02-0184.

Respectfully submitted,
Winfried K. W. Holscher

By/Barry L. Kelmachter #29999/
Barry L. Kelmachter
BACHMAN & LaPOINTE, P.C.
Reg. No. 29,999
Attorney for Applicants

Telephone: (203) 777-6628 ext. 112
Telefax: (203) 865-0297
Email: docket@bachlap.com

Date: August 31, 2009